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|---|-------------|----------------------|---------------------|------------------|
| 10/598,778  | 09/28/2007  | Salah E. Boukadoum   | 40398-104025        | 1232             |
| 23644   | 7590        | 04/30/2009           | EXAMINER            |                  |
| BARNES & THORNBURG LLP<br>P.O. BOX 2786<br>CHICAGO, IL 60690-2786 |             |                      | CHAMPAGNE, LUNA     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3627                |                  |
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|   |             |                      | 04/30/2009          | ELECTRONIC       |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent-ch@btlaw.com

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/598,778             | BOUKADOUM ET AL.    |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | LUNA CHAMPAGNE         | 3627                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 September 2007.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 11 September 2006 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7,10-18 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

*Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

2. Claims 8-9, 19-20 are rejected as non-statutory subject matter, which is not patent eligible under 35 U.S.C. 101.

The Examiner notes that the apparatus and system claims 8 and 19 are directed to software, *per se* (e.g. a machine readable information), which does not fall within one of the four statutory classes of invention.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8, 10 are rejected under 35 U.S.C. 102(e) as being unpatentable by Risafi et al. (6,473,500 B1).

Re Claims 8, 10, Risafi et al. teach a method for using a card distributed in retail at least one redemption site, the method comprising the steps of: providing a card, the card having a front side and back side, machine readable information on at least one of the front side and back side, the machine readable information containing account data, and account information indicia on at least one of the front side and back side, the account information indicia being at least partially different from the account data (see e.g. *fig. 3a, 3b, col. 11, lines 1-28*); associating a value with the card (the cards are typically

available in preset denominations e.g. \$10, \$50, \$100); and redeeming the value associated with the card in at least one redemption site (these cards can be used only when purchasing goods or services from that particular merchant) (see e.g. col. 2, *lines 1-5, 12-14*).

Re claim 15, Risafi et al. teach a method, further comprising the redemption site being an online Retailer (see e.g. col. 19, *lines 66-67*).

Re claim 16, Risafi et al. teach a method, further comprising the redemption site being an authorized merchant (see e.g. col. 3, *lines 58-61*).

Re claims 17, 18, Risafi et al. teach a method further comprising associating the value with the card by assigning a personal account number, and assigning a redemption rule to the personal account number; assigning the redemption rule being defining a group of merchants as authorized merchants and permitting redemption of the card value only at authorized merchants (see e.g. col. 2, *lines 8-12*; col. 1, *lines 15-17*; col. 19, *lines 23-27*).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (7,328,190 B2), in view of Flitcroft et al. (2003/0028481 A1).

Re claims 1, 2, and 5, Smith et al. teach a method for managing at least one transaction through using credit card authorization payment infrastructures, the method comprising the steps of: providing a personal account number, the personal account number corresponding to an account managed by an Issuer (col. 2, lines 57-59 – *the stored value card is distributed to a merchant for distribution to a customer who has an account with a specific provider of goods and/or services*); associating the personal account number with a predetermined value (*the indicia may be distributed on magnetic stripe cards having predetermined values, such as \$10, \$25, and \$50 cards*) ; assigning the personal account number to a stored value instrument upon activation of the stored value instrument (*the central processor may also transmit a PIN to the merchant terminal upon activation of the card*); and providing the stored value instrument to a Consumer (*for distribution to customer*) (see e.g. col. 7, lines 9-16; col. 19, lines 42-44) ; activating the stored value instrument at a point of sale (see e.g. col. 18, lines 33-42); further comprising allowing the Consumer to make a purchase using the stored value instrument (see e.g. col. 2, lines 61-63 – *The associated stored value is redeemable with one or more providers, including the specific provider*).

Smith et al. do not explicitly teach an account being in a format different from industry stand credit card number format.

However, Flitcroft et al. teach an account being in a format different from industry stand credit card number format (see e.g. paragraph 0044 – *the master account may but likely does not have the format of a standard credit card or the like*);

Therefore, it would have been obvious to a person of ordinary at the time of the invention to modify Smith et al., and include the step an account is in a format different from industry stand credit card number format, as taught by Flitcroft et al., in order to increase security and prevent fraud.

Re claim 3, Smith et al. teach a method, the step of providing a personal account number further comprising providing a plurality of personal account numbers to a PAN Facilitator (see e.g. col. 6, lines 22-36).

Re claim 4, Smith et al. teach a method, the step of providing a personal account number further comprising the PAN Facilitator selectively providing the at least one personal account number of the plurality of personal account numbers to a Retailer for use with at least one stored value instrument distributed by the Retailer (see e.g. col. 3, lines 12-14).

Re claim 6, Smith et al. teach a method, further comprising: communicating the personal account number and a proposed transaction to the Issuer – *the central system communicates with the customer's carrier system to add the service value to the customer; the system requests approval from the carrier system*); providing authorization from the Issuer

for the proposed purchase; and allowing the Consumer to make the proposed purchase (*adding value to a card is equivalent to a purchase transaction*) using the stored value instrument (*the system adds the service valued to the customer's account* (see e.g. col. 5, lines 36-37; col. 10, lines 52-57 –).

Re claim 7, Smith et al. teach a method, further comprising performing a settlement between, the Issuer and a PAN Facilitator (see e.g. col. 5, lines 49-51 – *the central system maintains arrangements with several carriers to allow for value insertion, and becomes a broker of prepaid communication services*).

7. Claims 9, 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risafi et al. (6,473,500 B1), in view of Flitcroft et al. (2003/0028481 A1).

Re claims 9, and 11, Risafi et al. do not explicitly teach an apparatus further comprising the machine readable information being in a format that is different from industry standard credit card authorization infrastructure information format.

However, Flitcroft et al. teach an account being in a format different from industry stand credit card number format (see e.g. paragraph 0044 – *the master account may but likely does not have the format of a standard credit card or the like*);

Therefore, it would have been obvious to a person of ordinary at the time of the invention to modify Smith et al., and include the step an account is in a format different from industry stand credit card number format, as taught by Flitcroft et al., in order to increase security and prevent fraud.

Re claim 12, Risafi et al. teach a method, the step of providing the card further comprising providing the card having machine readable information that is compatible with a gift card redemption system of a selected Retailer and the step of redeeming the value further comprising redeeming the value by processing the card using the gift card redemption system (see e.g. *fig. 10a; col. 9, lines 27-34*).

Re claims 13, 14, Risafi et al. teach a method, further comprising associating the value with the card by assigning a personal account number with the card at point of sale, and associating a balance with the personal account number; a method further comprising the step of redeeming the value being deducting a purchase amount from the balance (see e.g. *col. 4, lines 17-22, 25-28; claim 58*).

8. Claim 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risafi et al. (6,473,500 B1), in view of Walker et al. (6,193,155 B1).

Re claims 19, 20, Risafi et al. teach a system for distributing a card at retail that is redeemable at selected redemption sites, the system comprising: a card, the card having a front side and back side, machine readable information on at least one of the front side and back side, the machine readable information containing account data, account information indicia on at least one of the front side and back side, the account information indicia being at least partially different from the account data (see e.g. *fig. 3a, 3b, col. 11, lines 1-28*);

Risafi et al. do not explicitly teach a system wherein a personal account number associated card; a personal account number facilitation system; and a redemption site interface, the redemption site interface being operative to connect to the personal account number facilitation system in response to using the card at a redemption site.

However, Walker et al. teach a system wherein a personal account number associated card; a personal account number facilitation system (see e.g. col. 4, lines 9-11 securely redeeming gift certificates associated with a credit card or other financial account), or and a redemption site interface, the redemption site interface being operative to connect to the personal account number facilitation system in response to using the card at a redemption site (see e.g. fig. 13; col. 11, lines 61-67; col. 12, lines 1-4).

Therefore, it would have been obvious to a person of ordinary at the time of the invention to modify Risafi et al., and include the steps wherein a personal account number associated card; a personal account number facilitation system; and a redemption site interface, the redemption site interface being operative to connect to the personal account number facilitation system in response to using the card at a redemption site, as taught by Walker et al., in order to facilitate payment for the stored value instrument.

Re claim 20, Risafi et al. teach a system wherein the redemption site interface is a point of sale activation system (see e.g. col. 13, lines 20-25).

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sharma et al. (2005/0027655 A1); Arias (2006/0032911 A1)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUNA CHAMPAGNE whose telephone number is (571)272-7177. The examiner can normally be reached on Monday - Friday 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Luna Champagne/  
Examiner, Art Unit 3627

April 20, 2009

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627